

(617)

FAX RECEIVED

NOV 29 2002

GEI-073

GROUP 1600

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: : S. Qazi  
JACQUES PARIS et al :  
Serial No.: 09/423,109 : Group: 1616  
Filed: October 29, 1999 :  
For: NEW HORMONAL...AND ITS USE :  
  
OFFICIAL

600 Third Avenue  
New York N.Y. 10016  
November 27, 2002

RESPONSE

Asst. Commissioner for Patents  
Washington, D.C. 20231

Sir:

Responsive to the office action of October 11, 2002, Applicants request reconsideration of the application in view of the remarks presented herein.

The Examiner in the office action held that the reply of July 9, 2002 was non-responsive because the amendments filed did not correspond to the previous amendments and the Examiner was confused as to the exact history of the application. As a result thereof, the Examiner has required that Applicants submit a clear and complete copy of all the pending claims and deleting all the cancelled claims which are already of record.

In order to clarify the present matter, Applicants will recite the following history of the papers filed in the application.

(1) There was a preliminary amendment dated October 29, 1999 filed with the application to remove multiple dependency from the claims.

(2) There was an interview held with the Examiner and her supervisor, Jose Dees, together with Jacques Paris one of the inventors from France, the French patent attorney Dr. Burtin and Sylvie Delpy, an agent for the assignee of the present application, at which time, all of the claims were discussed and it was agreed that Applicants would submit claims drawn to a continuous administration of a combination of estradiol and noregesterol or one of its esters to prevent estrogen deficiencies in menopausal women. As a result of this interview, Applicants had hand-delivered to the Patent Office group the amendment of December 18, 2001 which added claims 18 to 30, cancelled claims 1, 2, 10 and 14 to 17 and amended claims 3 to 9 and 11 to 13.

(3) For some reason, the Examiner did not have the amendment of December 18 which had been hand-delivered to the Patent Office group when a different Examiner issued the restriction requirement dated December 28, 2001. For some reason, he required restriction between claims 1 to 17 which were not the claims in the application at the time of the restriction requirement.

(4) An office action was issued by an Examiner who was not part of the interview dated December 28, 2001.

(5) Applicants filed a response on January 25, 2002 indicating that there was an interview with Ms. Qazi and that the amendment had been hand-delivered on December 18, 2001 and it was requested that

the present application be transferred from Mr. Stiller who issued the December 28, 2001 restriction requirement to Ms. Qazi in view of the interview therein.

(6) The undersigned attorney and the previous participants from France had a second interview with Ms. Qazi and her supervisor Jose Dees on June 25, 2002. It was pointed out to the Examiner and her supervisor at the interview that the amendment had been filed on December 18, 2001 and was not entered at the time of the issuance of the office action. Applicants provided a copy of the said amendment again. At this interview, it was ascertained that there was an amendment filed January 12, 2002 which was not intended for the present application but was intended for patent application Serial No. 09/423,108 and inadvertently, there was a typographical error containing the serial number of the present application. It was pointed out to the Examiner that this amendment should be disregarded and/or transferred to the copending application. As a result of the interview on June 25, 2002, Applicants filed a response pointing out that there was a typographical error in the amendment of January 12, 2002 and that it should be disregarded.

(7) On August 13, 2002, the undersigned had an interview with Ms. Qazi on a non-related case and at the time of the interview, the present application was briefly discussed. The undersigned again pointed out to the Examiner that there was a typographical error and that the correct claims were those in the amendment of December

18, 2001.

As can be seen from the above discussion, the correct claims in the application are those set forth in the December 18, 2001 amendment, namely, claims 3 to 9, 11 to 13 and 18 to 30. Therefore, the Examiner is requested to act on these claims as set forth in the amendment of December 18, 2001 and she is to ignore the amendment filed on January 12, 2002 since it does not belong to the present application.

Respectfully submitted,  
Bierman, Muserlian and Lucas

By: Charles A. Muserlian  
Charles A. Muserlian #19,683  
Attorney for Applicants  
Tel.# (212) 661-8000

CJM:ds

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Charles A. Muserlian

11-27-02

Charles A. Muserlian